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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/640,369	08/17/2000	Victoria J. Freeman	0065292	5206

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EXAMINER

ASHBURN, STEVEN L

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/640,369	FREEMAN, VICTORIA J.	
	Examiner	Art Unit	
	Steven Ashburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 103

Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hopkins et al., U.S. Patent 4,756,533 (Jul. 12, 1988) in view of Pritchard, U.S Patent 1,217,632 (Feb. 27, 1917).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Response to Arguments

Applicant's arguments filed November 13, 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, the applicant argues that the features in the specification limit the terms "literary work", "associated with an advertisement", "playing pieces", "prize" and "distinct parts". However, these limitations are not read into the claims. Consequently, the applicant's argument that these features distinguish the claimed invention over the prior art is not persuasive.

The applicant argues that the claimed invention distinguishes over the prior art because neither *Hopkins* nor *Pritchard* discloses the preamble's recitation of "promoting literacy". The examiner respectfully disagrees. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are

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able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In this case, the claim's preamble states "a method for promoting literacy and reading by conducting a competition related to a literary work in association with an advertisement". The examiner interprets the preamble portion of "promoting literacy" as merely reciting an intended use of the game. The body of the claim is directed toward a game and does not depend on the preamble for completeness. Hence, the preamble's recitation of "promoting literacy" has not been given patentable weight.

Furthermore, the applicant argues that the claimed invention distinguishes over the prior art because neither *Hopkins* nor *Pritchard* individually discloses the features of the claimed invention. The examiner respectfully disagrees. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The standard of patentability is what the prior art, taken as a whole, suggests to an artisan at the time of the invention. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The question is not only what the references expressly teach, but what they would collectively suggest to one of ordinary skill in the art. *In re Simon*, 461 F.2d 1387, 1390, 174 USPQ 114, 116 (CCPA 1972).

In this case *Hopkins* discloses a lottery game designed for promotional and advertising uses. See *col. 1:55-2:8*. The invention combines both luck and skill to present a particularly challenging lottery game. See *id.* The invention employs multiple jig saw puzzles which each contestant must play simultaneously. See *id.* To increase the challenge of the game, all the jig saw puzzles use identical jig saw patterns, all the boards having identical shaped puzzle pieces in identical positions. See *id.* The puzzle pieces are distributed from a common pool, without indication of which puzzle each piece may solve. See *id.* Each contestant thus is challenged to collect all the required puzzle pieces and, using only the visual clues on the face of each piece, to separate the pieces and then solve the various jig saw

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puzzles. *See id.* The invention encourages on-going contestant participation, making it very useful for promotional activities. Additionally, the invention is readily combined with "instant win" games and sweepstake lotteries to maximize contestant participation. *See id.* *Pritchard* discloses an analogous puzzle game useful for advertising purposes. *See p. 1:8-25, 1:105-2:2.* In particular, the reference teaches a "puzzle book" in which puzzle pieces are parts of a literary work. *See fig. 4, 5; p. 1:35-53, 1:97-104.* *Pritchard* suggests these picture puzzles are beneficial because they are entertaining, instructive and may be varied so as to be as difficult as desired. *See p. 1:105-109.*

Consequently, when taken as a whole, the prior art suggests to an artisan at a time prior to the invention a lottery puzzle game wherein puzzle pieces that are parts of a literary work are collected and assembled by players to win a prize. As suggested by *Pritchard*, the modification would enhance the puzzle by making the game entertaining, instructive and of variable difficulty. *See p. 1:105-109.*

Still furthermore, applicant asserts that the prior art fails to describe certain features of the claimed invention. These assertions are listed in the chart contained on pp. 9-10 of the applicant's response. For reasons already discussed above, the arguments are not persuasive. First, the features upon which the arguments rely are not recited in the rejected claims. *See supra.* Second, the chart attempts to show nonobviousness by attacking references individually where the rejections are based on combinations of references. The arguments fails to consider not only what the references expressly teach, but what they would collectively suggest to one of ordinary skill in the art. Consequently, the arguments are unpersuasive.

Even still furthermore, the applicant asserts that there is no suggestion to combine the references. In response, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available

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to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, *Hopkins* and *Pritchard* disclose analogous puzzle games. *Pritchard* suggests modifying the puzzle game disclosed by *Hopkins* to employ literary works because the modification enhances a puzzle by making the game entertaining, instructive and of variable difficulty. See p. 1:105-109. Hence, the applicant's argument is unpersuasive because the suggestion to combine was found within the reference itself. The examiner notes that it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991).

For all the reasons set forth above, the rejection of claims 26-28 is maintained.

Conclusion


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are

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unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1148.

s.a.



MARK SAGER
PRIMARY EXAMINER